

REMARKS

Claims 1, 14 and 19 have been amended by this paper. Claims 11-13, 17, and 18 were nonelected and therefore were withdrawn previously and Claims 2-10, 15-16 and 20-21 remain unchanged by this Amendment. Claim 22 has been added. Hence, by this paper, Claims 1-10, 14-16, and 19-22 are presented for further examination.

I. Discussion of Rejection of Claims 1-10, 14-16, 19-21 Under 35 U.S.C. § 102(e)

In an Office Action mailed May 9, 2003, Claims 1-10, 14-16, and 19-21 were rejected as being anticipated by *Slivka, et al.* (U.S. Patent No. 6,061,695, hereinafter "*Slivka*") under 35 U.S.C. § 102(e). For the reasons set forth below, Applicant respectfully disagrees with the Examiner's findings and determination that Claims 1-10, 14-16, and 19-21 are anticipated by *Slivka*.

A. Brief Description of *Slivka*

Slivka describes an operating system shell which provides a graphical user interface having a windowing environment with a desktop. The shell synthesizes a hypertext page for display as the desktop in the graphical user interface. The hypertext pages are synthesized from templates which can be edited to incorporate a variety of multi-media enhancements with the user interface elements in the graphical user interface.

B. The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

C. *Slivka* Fails To Anticipate The Claimed Invention

One embodiment of the claimed invention is directed to performing maintenance and diagnostic actions. In particular, Claim 1 recites "performing an initial action with respect to the electronic device responsive to receiving the activated hypertext link; and wherein the initial

action is one of downloading a device driver identified with a hardware component of the electronic device, generating a disk image, or installing a service pack.” As discussed below, Applicant submits that *Slivka* does not teach or suggest, at least, this limitation.

First, in rejecting Claim 7 containing similar subject matter to amended Claim 1, the Examiner took the position that *Slivka* teaches execution of a routine to identify a device to install. See *Office Action*, page 3, para. 8. The Examiner argued that the *Slivka* teaching of “tags” anticipates the action of “identify a device to install.” *Id.* Applicant submits that the cited portion of *Slivka* merely teaches the use of embedded object tags to instantiate desktop controls, including installing those controls if needed, during parsing of the HTML file as part of the presentation of the HTML. See *Slivka*, col. 17, lines 32-42. Applicant submits that the *type* of action that is performed by *Slivka* is different than what is claimed by the present invention. In particular, Claim 1 is directed to downloading device drivers, generating disk images, and installing service packs. In *Slivka*, the downloaded desktop control is not a device driver identified with a hardware component for the computer. Further, *Slivka* does not teach, at least, performing the actions of generating disk images, and installing service packs.

In rejecting Claim 8, the Examiner took the position that *Slivka* teaches certain features of generating a disk image. See *Office Action* page 4, para. 1. The Examiner indicated that this is disclosed in *Slivka* by “MWAVTSR icon of the screen 180, fig. 7.” Applicant submits that the “MWAVTSR” icon refers to a component of VSAFE virus scanning software which unrelated to “generation of a disk image” as now recited by Claim 1. Further, Applicant submits that nowhere does *Slivka* teach or suggest “performing an initial action with respect to the electronic device ... wherein the action is ... installing a service pack” as recited by Claim 1, as amended.

In view of the above, Applicant submits that Claim 1, as amended is currently allowable. Because Claims 14 and 19 each recite at least some of the patentable features discussed in connection with Claim 1, Applicant submits that Claims 14 and 19 are also allowable. Furthermore, Applicant respectfully submits that Claims 1-10, 14-16, and 19-21, which each depend from one of Claims 1, 14 and 19, also define subject matter which is patentable over the art of record for at least the reasons set forth above.

II. Conclusion

Applicant has endeavored to address all of the Examiner’s concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes,

Appl. No. 09/349,735
Amdt. Dated August 20, 2003
Reply to Office Action of May 5, 2003

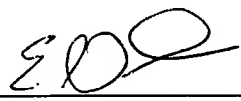
the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: August 20, 2003

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